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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,357

Applicant(s)

YAM, DANIEL

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-101 is/are pending in the application.
- 4a) Of the above claim(s) 66, 67, 69, 74-76, 82, 83, 93-96 and 101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-65, 68, 70-73, 77-81, 84-92 and 97-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) &9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Applicant's election with traverse of Group II, and fish oil as the liquid oil, beeswax as the fat, and a flavoring agent as the additional agent in Paper No. 11 is acknowledged. The traversal is on the ground(s) that group II and III are closely related since the first being the nutritional supplement and the second being the food additive in which the supplement is contained. This is found persuasive and group III is joined to group II and are herein examined. Applicants' further traversal is on the ground that all the claimed invention have the same or corresponding special feature, since they all depend on claim 61. This is not found persuasive because even though the claimed inventions employ same materials, they still involve other patentably distinct issues as discussed in the prior office action. Applicants' traversal on the species election is on the ground that there is no provision under PCT rules for such an election of species requirement. This is incorrect. Applicants' attention is directed to PCT rule 1.31 and 1.32.

The rest restriction requirement is still deemed proper and is therefore made FINAL.

2. Claims 93-96 and 101 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, and claims 66, 67, 69, 74-76, 82 and 83 are withdrawn from further consideration, as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

The claims have been examined insofar as they read on the elected invention and species.

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Claim Objection

3. Claim 91 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Particularly, claim 90 has limitation of "about 20% to about 50% of beeswax," claim 91 has limitation "about 83% by weight of fish oil," indicating the amount of beeswax is less than 17%, which is not within the scope of claim 90. Therefore, claim 91 is not further limiting claim 90.

Claim Rejections 35 U.S.C. 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 73 and 86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 73 and 86 recite a composition of fish oil and beeswax, wherein the composition comprising 60% by weight of omega-3 polyunsaturated fatty acid. This would require that the fish oil has a concentration of omega-3 PUFA 60% or higher. However, it is known in the art that natural fish oil only contains below 35 % of omega-3 PUFA. (see Cain et al. column 1, line 13-31). Applicants fail to provide proper guidance, direction, or working examples for making refined fish oil with more than 60% by weight of omega-3 PUFA. Note, a

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trade mark (see example 1 in the specification) is not considered a proper description for an ingredient that is essential for the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 73, 77, 84-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 73 and 86 recite the limitation "omega-3 polyunsaturated fatty acids" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

9. The term "suitable" in claims 84-88 is a relative term which renders the claim indefinite. The term "suitable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and envisioned as "suitable", thus, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The claims are indefinite as to the requirement to make the paste "suitable" for spreading.

10. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of

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the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 90 and 92 recite the broad recitation "at least 50%," and the claim also recites "at least 80%" which is the narrower statement of the range/limitation.

11. Claims 89-91 recite "solid paste." There is no clear definition of the "solid paste" in the specification. "paste" by definition, is a soft plastic mixture of liquid and solid. "Solid" and paste have contradicting meanings. Therefore, the phrase "solid paste" is confusing as to the exact meaning. The claims are indefinite as to the morphology of the paste.

Claim Rejections 35 U.S.C. 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 61-65, 68, 70-73, 77-81, 84-92, and 97-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. (U.S. Patent 6,020,020) in view of W. R. Grace (GB Patent 1,146,558) in further view of Moskowitz (U.S. Patent 5,268,186), Merck index and applicants admission at page 7, lines 20-26 and page 12, line 1-11.

14. Cain teaches and claims a fat blend comprising up to 95% of a fish oil, which containing at least 40% by weight of omega-3 long chain polyunsaturated fatty acid, and a complementary fat having a solid fat. See, particularly, claims 1-8. The supplementary fat provides structural

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properties of the fat blend. A variety of fats containing solid fat may be used as supplementary fat. Optimization of the amounts of supplementary fat in the composition may accordingly be carried out (See, particularly, column 2, lines 6-33). This blend is suitable for food product such as spreads, margarine, cream, etc (See, claim 9). Cain teaches that the health benefit of omiga-3 polyunsaturated fatty acid is well known in the art (See, column 1, lines 13-31).

15. Cain does not teach expressly the employment of beeswax as a fat supplement to provide solid fat components, the particular concentration of each ingredients, or the particular method of making the composition.

16. However, W. R. Grace teaches that beeswax is useful for making a fatblend, which is suitable for spreads or other food product. See, particularly, page 3, lines 7-20. Further, it is well known in the art that beeswax comprising long chain fatty acid ester is solid at room temperatur (See, Merck Index, 1031).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ beeswax as supplementary fat to provide structural properties in Cain's fatblend. A person of ordinary skill in the art would have been motivated to employ beeswax as supplementary fat in Cain's fat blend because beeswax is particularly known to be useful for making fatblend suitable for spreads, and beeswax is well-known to containing solid fat. Further, employment of fish oil containing a high concentration of polyunsaturated fatty acid, (e.g., 80% omiga-3 polyunsaturated fatty acid) is obvious since it is known that high concentration of omiga-3 polyunsaturated fatty acid in a fatblend is desirable, and the high concentration omiga-3 polyunsaturated fatty acid is available publicly at the time the claimed invention was made (See, page 7, lines 20-26 and page 12, line 1-11 in the

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specification). Further, making a fatblend by heating, mixing and cooling is considered within the skill of artisan. The optimization of a result effective parameter, e.g., the morphology of the blend, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Finally, employment of a flavoring agent known to be useful in food, such as parmesan cheese flavor, in a composition used for food product is obvious (See Moskowitz, column 6, example V).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Travers, J.D., can be reached on (703) 308-4603. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner



Shengjun Wang

August 4, 2002